REMARKS

The Examiner has objected to the title and abstract. Such objections are deemed avoided by virtue of the clarifications made to the specification.

The Examiner has rejected Claims 9-11, 21-23 and 33-35 under a nonstatutory double patenting rejection. Applicant has included herewith a terminal disclaimer to overcome such rejection.

The Examiner has rejected Claims 9-11, 21-23 and 33-35 under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (U.S. Patent No. 6,779,021) in view of Dieterman (U.S. Patent No. 6,393,464). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has amended each of the independent claims to incorporate the following additional claim language which clarifies applicant's claims:

> "wherein a rule associated with the e-mail filtering logic is added if a threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message;
>
> wherein said e-mail filtering logic uses a scoring algorithm responsive to identification of predetermined words within said received e-mail message and a message size of said received e-mail message to identify said received e-mail message as a potentially unwanted e-mail message" (see the same or similar, but not identical language in each of the independent claims).

Applicant respectfully asserts that neither the Bates nor Dieterman references teach such claim language. In particular, Dieterman simply teaches comparing senders of received emails against a list of names on an approved list (see Abstract). However, Dieterman does not teach any sort of "threshold of a predetermined number of votes" in the context claimed by applicant. Furthermore, Bates only teaches that "if a particular number of users respond that a particular e-mail marked as spam is not spam, then [the]

prediction application 42 may...designate that the particular e-mail should not be marked as spam for future entries" (see Col. 8, lines 23-28). Applicant, on the other hand, claims that "a rule... is added if a threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message" (emphasis added).

In addition, neither the Bates nor Dieterman references teach "a scoring algorithm responsive to identification of predetermined words within said received e-mail message and a message size of said received e-mail message to identify said received e-mail message as a potentially unwanted e-mail message," as claimed by applicant. Specifically, Bates only generally discloses a "[n]etwork filter 40 [that] filters through each e-mail and predicts its likelihood as undesirable mail or spam" (see Col. 6, lines 15-17). Clearly, such a general teaching from Bates does not rise to the level of specificity of applicant's claim language since applicant claims the scoring algorithm to be "responsive to identification of predetermined words within said received e-mail message and a message size of said received e-mail message" (emphasis added), as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or

a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 37-43 below, which are added for full consideration:

"wherein said scoring algorithm is responsive to an addressee list of said received e-mail message" (see Claim 37);

"test creating logic operable to allow creation of a new test to be added to said at least one test provided by said e-mail filtering logic" (see Claim 38);

"wherein said computer program is arranged to receive and process e-mail messages before said e-mail messages reach an associated target e-mail server" (see Claim 39);

"wherein said prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail if an administrator identifies said e-mail message as being wanted" (see Claim 40);

wherein said rule associated with said e-mail filtering logic is confirmed manually" (see Claim 41);

"wherein said manual confirmation is not required if a predefined number of highly trusted users positively identify said potentially unwanted e-mail message as an unwanted e-mail message" (see Claim 42); and

"wherein said prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail and said rule is not added if said rule is not confirmed manually" (see Claim 43).

Again, a notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P445/00.174.01).

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